

### **REMARKS/ARGUMENTS**

The Office Action mailed September 20, 2004 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested. Claims 11, 12, and 17 are currently pending.

Claim 11 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for this changes may be found in the specification. No new matter had been added.

#### **Informal Objection**

Claim 11 stands objected to because it “is not clear if it is directed to a cutting device or a combination of cutting device and a medical device system. While the preamble merely states the cutting device, the body of the claim sets forth a combination of cutting device and medical device system. It is assumed to be the combination for examination purpose.”

Applicant's are still is unclear of what is requested since the Examiner did not clearly state what correction is required. However, Claim 11 has been amended to indicate that the claimed invention is directed to a cutting device and not a medical device system. It is respectfully requested that this objection be withdrawn.

#### **The 35 U.S.C. § 103 Rejection**

Claims 11-12 and 17 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over “Applicant's Admitted Prior Art” (hereafter AAPA) in view of Jones (US 2,847,759) and Krol (US 4,573,576)”, among which claim 11 is an independent claim. This rejection is respectfully traversed.

The 35 USC 103(a) rejection can not be maintained against AAPA

According to M.P.E.P. §2136.02, “[f]or applications filed on or after November 29, 1999, if the applicant provides evidence that the application and prior art reference were ... subject to an obligation of assignment to the same person, ... any rejections under 35 U.S.C. 103 based upon such a commonly owned reference should not be made or maintained.” Furthermore, MPEP §706.02(I)(2)(II) specifically states:

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

In the Office Action, the Examiner did not address Applicant's argument and still maintains his rejection under 103(a) using AAPA. As previously stated, WO99/56692 relates to USP 6162192 ('192). '192 and the present application, were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity, Sub-Q, Inc. The assignment for '192 is located on Reel/Frame 9371/0797.

Additionally, WO99/56632 relates to USP 6071301 ('301). '301 and the present application, were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity, Sub-Q, Inc. The assignment for '301 is located on Reel/Frame 9370/0437.

The claimed invention is not obvious in view of the prior art references

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.<sup>1</sup>

In the event the Examiner maintains the argument above, Applicant will respectfully respond to further prosecution of this application.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in AAPA except that AAPA does not teach “the cutting device comprising a base having an opening with cutting edges, and a flap having cutting edges, a card mounted on the base and supporting the medical device system.” The Office Action further contends that Jones teaches “a cutting device including a base (24) having an opening and cutting edges corresponding to the cutting edges of the opening” and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Jones into AAPA in order to “provide accurate and easier cutting operation.” The Office Action further contends that “Krol teaches mounting a medical kit on a card to provide easy access to the tools within the kit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the card as taught by Krol for the device AAPA to provide easy access to the tools within the kit. Moreover, one having ordinary skill in the art would have been motivated to mount the cutting device on the card in order to provide a ready to use cutting device on the card

supporting the medical device system. It has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.”

The Applicants respectfully disagree for the reasons set forth below.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine AAPA with Jones and Krol. Jones specifically states that its cutting card device is “a device for notching cards of a certain type in the edges thereof to provide notches extending into previously cut openings in the card.” (Col. 1, lines 12-15; Col. 2, lines 41-57). Thus, the invention of Jones is used to cut specific types of cards having previously cut opening. Jones was filed on April 4, 1957 and issued in August 19, 1958 and there is no suggestion or motivation to combine AAPA, which deals with **medical devices**, with Jones. Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant’s teaching to modify a prior art reference is an impermissible use of “hindsight.” *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Moreover, the alleged combination of the prior art would not result in the claimed invention. Krol merely teaches attaching objects on a card to provide easy access to the tools, but does not teach having a cutter on the card. The card cutter of Jones could not feasibly be mounted onto a card since the cutter of Jones is operated using “an opening 11 over which the thumb of one hand is adapted to be placed as the body of the device is grasped in such hand to facilitate the operation of the device.” (Col. 1, lines 63-66). Mounting the cutter of Jones on a card will not allow for ease of operation of the device. Applicants assumes that the Office Action intended to take official notice of facts under M.P.E.P. 2144.03 that the rationale

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<sup>1</sup> M.P.E.P. § 2143.  
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supporting the obviousness rejection (namely, 1. one having ordinary skill in the art would have been motivated to mount the cutting device on the card in order to provide a ready to use cutting device on the card supporting the medical device system and 2. forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art) is based on common knowledge in the art or "well-known" prior art. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action

Lastly, the combination of the prior art references do not teach or suggest all the claim limitations. The combination of the prior art references do not teach a base mounted on a card supporting a medical device system for delivering a foam material. Specifically, the combination of the prior art references do not teach having a "base having an opening with cutting edges; a flap articulated with respect to the base, ... and wherein the base is mounted on a card, and the card supports a medical device system for delivering a foam material" as claimed in Claim 11. As such, for the reasons described above, among others, the prior art references do not suggest or teach all the claim limitations of Claim 11.

#### Dependent Claims

As to dependent claims 12 and 17, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance. It is respectfully requested that this rejection be withdrawn.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

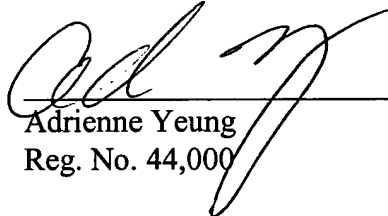
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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Dated: March 21, 2005

  
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